

REMARKS

Claims 1 to 29 are pending in the application. The Examiner has subjected the claims to an election of species requirement and claims 4, 5, 15, 18, and 19 have been withdrawn from consideration. Claims 1 to 3, 6 to 9, 16, 17, and 22 to 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Peeters et al. (U.S. Patent 6,328,409) in view of JP 03-100561. Claims 10 to 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Peeters et al. in view of JP 03-100561 and further in view of Patel et al. (U.S. Patent 5,403,693). Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Peeters et al. in view of JP 03-100561 and further in view of Sacripante et al. (U.S. Patent 5,348,832).

Applicants have cancelled withdrawn claims 4, 5, 15, 18, and 19. Applicants believe that these amendments place the claims in better condition for appeal.

Applicants continue to traverse the rejections of the claims. In response to Applicants' position as set forth in the Amendment dated June 14, 2006, the Examiner has stated that Peeters et al. broadly teaches a toner and does not limit the invention, neither prescribing nor proscribing any one toner exclusively, that because this reference is silent with respect to the particular toner composition, one of ordinary skill in the art would have looked to the prior art to find a suitable composition, and that the selection of a known material based on its suitability for its intended use has been held to support a prima facie case of obviousness.

Applicants disagree with this position. As the Examiner has stated, Peeters et al. neither prescribes nor proscribes any one toner exclusively. Accordingly, one of ordinary skill would not be led, based on the teachings of Peeters et al., to believe that a marking material such as that disclosed in JP 03-100561 would be either suitable or unsuitable for use in the Peeters et al. invention. While, as the Examiner states, one of ordinary skill in the art may have looked to the prior art to find a suitable composition, nothing in Peeters et al. would have led one of ordinary skill in the art to believe that the particular composition disclosed in JP 03-100561 would be more suitable for use in the invention disclosed therein than the many, many thousands of other toner compositions disclosed in the prior art.

Similarly, nothing in JP 03-100561 teaches or suggests to one of ordinary skill in the art that it would be suitable for use in the invention disclosed in Peeters et al. The Examiner has stated that the selection of a known material based on its suitability for its intended use has been held to support a prima facie case of obviousness. In this instance, however, the intended use for the JP 03-100561 material is electrophotography, not ballistic aerosol marking. Accordingly, Applicants are of the position that the Examiner has failed to establish a prima facie case of obviousness, and respectfully request reconsideration and withdrawal of this ground for rejection.

Further in response to Applicants' position as set forth in the Amendment dated June 14, 2006, the Examiner has stated that JP 03-100561 clearly teaches polymerization in an "emulsion suspension", which, because Applicants' specification provides no definition of "an

emulsion aggregation process" that excludes such a process as this one taught by JP 03-100561, reads on the claimed invention.

Applicants disagree with this position. The emulsion aggregation process is specifically defined in the present specification at, for example, page 74, lines 16 to 27. This process entails (1) preparing a colorant (such as a pigment) dispersion in a solvent (such as water), which dispersion comprises a colorant, a first ionic surfactant, and an optional charge control agent; (2) shearing the colorant dispersion with a latex mixture comprising (a) a counterionic surfactant with a charge polarity of opposite sign to that of said first ionic surfactant, (b) a nonionic surfactant, and (c) a resin, thereby causing flocculation or heterocoagulation of formed particles of colorant, resin, and optional charge control agent to form electrostatically bound aggregates, and (3) heating the electrostatically bound aggregates to form stable aggregates of at least about 1 micron in average particle diameter. Further details regarding the process are disclosed in the specification and illustrated in the working examples. In addition, previous U.S. patents disclosing the emulsion aggregation process are incorporated by reference into the specification. The Examiner has pointed to nothing in JP 03-100561 that teaches or suggests such a process.

Further in response to Applicants' position as set forth in the Amendment dated June 14, 2006, the Examiner has stated that there is no evidence of record establishing the definition of a "high polymer" and that Applicants' polypyrrole having not more than about 100 repeat monomer units is exclusive of a "high polymer" so defined. The Examiner has produced a definition from *Alger's Polymer Science Dictionary*, 2nd

Edition, defining a "high polymer" as one having a high degree of polymerization and hence of a high molecular mass, and typically a degree of polymerization of more than about 100. The Examiner has further cited Alger to indicate that "degree of polymerization" refers to the number of repeat monomer units.

The Examiner has argued that the ordinary and conventional meaning of the term "high polymer" is inconclusive of polymers having "about 100 monomer units". Applicants, however, are of the position that the definition provided by the Examiner supports Applicants' position that, while JP 03-10056 teaches a toner having a high polymer adhered to the surface of the core, the toner as recited in claim 17 comprises particles of a resin and an optional colorant, said toner particles having coated thereon a polypyrrole, said polypyrrole having no more than about 100 repeat monomer units, and that this claim is thus particularly in condition for allowance. As the dictionary definition indicates, high polymers are typically those with a degree of polymerization of more than about 100, whereas the polypyrrole recited in claim 17 has no more than about 100 repeat monomer units. Applicant believe that these two definitions are clearly mutually exclusive.

For the aforesaid reasons and the reasons set forth in the previous Amendments, Applicants believe that the foregoing amendments and distinctions place the claims in condition for allowance, and accordingly respectfully request reconsideration and withdrawal of all grounds for rejection.

Application No. 10/762,155

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Applicant(s) attorney, Judith L. Byorick, at Telephone Number (585) 423-4564, Rochester, New York.

Respectfully submitted,



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